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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,884	01/31/2001	Jinichiro Kato	01197.0224	6497

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EXAMINER

GUARRIELLO, JOHN J

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/12/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744884

Applicant(s)

Kato et al. #10

Examiner

John Guarniello

Group Art Unit

1991

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 12/2/2002.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-30 is/are pending in the application.
- Of the above claim(s) 8-30 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-7 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Applicant Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3-7 ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

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DETAILED ACTION

Election/Restrictions

15. The Examiner acknowledges the affirmation of the Restriction which was required under 35 U.S.C. 121 and 372 to Group I, claims 1-7, Claims 8-16 are withdrawn as to a non-elected invention. The Examiner acknowledges the traverse of Restriction and the election of claim 17 as the species of election. New claims 20-30 are directed to process, 20-24 which are assigned to original Group II process, and fiber, claims 25-30 assigned to original Group III, these new claims are withdrawn as to the non-elected invention.

Applicant's arguments regarding the process claims 8-12, 20-24 requiring the solution of claims 1-7 have been considered but the process does not necessarily require that particular solution of polyketone, see Lommerts et al. 5,194,210, (abstract;column 2, lines 5-68). Furthermore, the special technical feature does not make a contribution over the art, see Lommerts et al.

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5,194,210, (abstract; column 2 lines 5-68), then no unity exists between the groups. Regarding the fiber claims requiring the claims 1-7 of that particular solution this is not necessarily the case as noted in applicant's remarks page 6, paragraph 2, the traversal has been considered but the arguments of the traversal are not deemed to be persuasive.

Claim Rejections - 35 USC § 112

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is the Examiner's position that the preamble of the claim is being interpreted as a material which is composed of a copolymer of carbon monoxide and one or more olefins with a solvent as noted in the stated Markush Group.

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In claim 2, line 4, the term "polymer" is not clear as to what the correct antecedent basis is for claim 1. The term "polymer" does not appear in claim 1, the term "polyketone" appears apparently as intended use. The claim is directed, claim 1, to a **solution**.

In claim 3, line 2, it is not clear what the term "halogen" refers since in the context of the claim it appears that the appropriate term in the ionic state should be **halide** not "halogen". Note claims 5-7 where the term is "halide" referring to the salts of the solvent.

In claim 5, it is the Examiner's position that the preamble of the claim will be interpreted as noted above in claim 1.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Ash 5,955,019.

Ash describes a process for making filaments or fibers of polyketones, (see abstract). Ash describes the solvents are zinc and lithium based halide solutions, (see abstract). Ash describes the production of fibers with alternating aliphatic polyketones, (column 1, lines 10-11). Ash describes Zn salts of aqueous solutions, (column 1, lines 49-60). Ash describes the polyketone polymers, (column 2, lines 1-47). Ash describes the amount of the solvent overlaps the amount of the claimed invention, (column 3, lines 30-36). It is the Examiner's position that Ash describes the essential limitations of the claimed invention. Claims lack novelty.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ash 5,955,019 in view of Lommerts et al. 5,194,210.

Ash describes the solution of polyketone as noted above in paragraph # 18 with the difference regarding the amounts of the weight ratios of the halides and the amount of the polyketone polymer.

Lommerts describes a solution of polyketone used for fibers as reinforcing yarns in making tires among other articles which have high tensile strength, (column 5, lines 33-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the amounts of the weight ratios of the alkaline halides since it has been held that discovering an optimum value of these ratios involves only routine skill in the art, In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Regarding the tire claim 17 it would have been obvious to one of ordinary skill in the art to employ the tire fibers of Lommerts for the fiber produced by the solution of Ash.

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21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is 703-308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



John J. Guarriello:gj

Patent Examiner

February 4, 2003

February 10, 2003



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
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